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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,280	08/27/2003	Akira Mizuta	Q76402	4443
23373	7590	11/09/2006		
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER NORDMEYER, PATRICIA L				
ART UNIT			PAPER NUMBER	
1772				

DATE MAILED: 11/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/648,280

Applicant(s)

MIZUTA, AKIRA

Examiner

Patricia L. Nordmeyer

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-12 is/are pending in the application.
- 4a) Of the above claim(s) 4-9 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Withdrawal of Finality

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn per the Pre-Brief Appeal Conference Decision dated September 1, 2006.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1, 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “which is adhered via the adhesive film to a recording surface of a disk substrate of an optical disk” in claim 1 is unclear, which renders the claim vague and indefinite. It is unclear from the claim language and specification how the adhesive film is adhered to the recording surface of an optical disk when the surface of the adhesive film is adhered to a peeling sheet. How can the adhesive film be adhered to both the peeling sheet and the recording surface of an optical disk?

Claims 10 and 11 are rejected 35 U.S.C. 112 1st and 2nd paragraphs due to their dependency on the above rejected claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shigetomi et al. (USPN 6,287,661) in view of JP 2000-67468.

For the purposes of examination, the Examiner is viewing the structure of the cover sheet package to be a thin film cover sheet that is has a protective sheet on one surface and is adhered to a recording surface of an optical disk on the other surface.

Shigetomi et al. disclose a cover sheet package (Column 1, line 6) comprising a thin film cover sheet including a resin film (Column 2, lines 22 – 29), the thin film cover sheet having an adhesive film formed on one side surface of the resin film (Column 2, lines 62 – 65), and which is adhered via the adhesive film to a recording surface a disk substrate of an optical disc (Column 1, lines 6 – 7); a peeling sheet which is peelably adhered on a surface of the adhesive film of the cover sheet and which is peeled before the cover sheet is adhered to the recording surface of the disk substrate (Column 3, lines 51 – 57); and a protective sheet which is peelably adhered on a

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surface of the resin film of the cover sheet (Column 2, lines 55 – 57) as in claim 1. With regard to claim 1, the cover sheet, the resin film and adhesive film, has a total thickness that ranges from 13 micrometers to 300 micrometers (Column 2, lines 43 – 45; Column 3, lines 46 – 48). However, Shigetomi et al. fails to disclose the thin film cover sheet being adhered via the adhesive film to a recording surface of a disk substrate.

JP 2000-67468 teaches a film adhered to the recording surface of a optical disk via an adhesive film (Abstract, lines 5 – 6) for the purpose of obtaining an optical disk that is capable of dealing with the shortening of a laser wavelength (Abstract, lines 1 – 2).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the film adhered to the recording surface of an optical disk in Shigetomi et al. in order to obtain an optical disk that is capable of dealing with the shortening of a laser wavelength as taught by JP 2000-67468.

With regard to the limitations of “when an adhesive force for adhering the peeling sheet to the adhesive film of the cover sheet is indicated by AP_1 and an adhesive force for adhering the protective sheet to the resin film of the cover sheet is indicated by AP_2 , the peeling sheet is adhered to the adhesive film of the cover sheet and the protective sheet is adhered to the resin film of the cover sheet so that the relationship AP_1 less than or equal to AP_2 is satisfied by the release coating that is formed on the liner material and the adhesive force AP_1 is set to be a value selected from a range of 5 to 50 g/cm and the adhesive force is set to be a value selected from a

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range of $(AP_1 * 1.0)$ to $(AP_1 * 3.0)$ " in claim 1, since the Examiner has taken the position that the peeling sheet has been removed (see the 112 2nd paragraph rejection and 103(a) rejection above), these limitations are no longer relative to the claimed subject matter as AP_1 has no value.

Response to Arguments

6. Applicant's arguments with respect to claims 1, 10 and 11 have been considered but are moot in view of the new ground(s) of rejection. However, since the same prior art is being applied in the above rejection, the arguments will be responded to below.

In response to Applicant's argument that both Shigetomi and Liu fail to disclose the cover sheet attached to the recording surface of the optical disk, please see the above rejection. Also, Shigetomi discloses the film attached to the recording surface of the optical disk as nothing in claim language states that the film has to be "directly" adhered to the recording surface. Shigetomi teaches a film adhered a surface of the optical disk, and the open language of the claim, i.e. comprising, allows for layers to be in between the film and the recording surface of the optical disk. Lastly, to the limitation of "which is peeled before the cover sheet is adhered to the recording surface of the disk substrate" in claim 1, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 10:00-7:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer
Examiner
Art Unit 1772

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pln

Nasser Ahmad 11/7/06
NASSER AHMAD
PRIMARY EXAMINER